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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/006,352    01/13/98    GENTZ    R    PF454

022195  
HUMAN GENOME SCIENCES INC  
9410 KEY WEST AVENUE  
ROCKVILLE MD 20850

HM12/1207

EXAMINER

BECKERLEG, A

ART UNIT

PAPER NUMBER

1632

13

DATE MAILED:

12/07/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Office Action Summary**

Application No.  
**09/006,352**

Applicant(s)  
**Gentz**

Examiner  
**Anne Marie S. Beckerleg**

Group Art Unit  
**1632**



☒ Responsive to communication(s) filed on Jul 11, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

☒ Claim(s) 19-305 is/are pending in the application.

Of the above, claim(s) 19-23 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 24-305 are subject to restriction or election requirement.

**Application Papers**

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### ***Continued Prosecution Application***

The request filed on 6/21/00 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/006,352 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Election/Restriction***

Applicant's response to the restriction requirement received on 6/21/00 has been entered. Claims 1-18 have been canceled and new claims 24-305 have been added. Applicant's election with traverse of invention I, claims 1-18, drawn to isolated polynucleotides, recombinant vectors containing the same, host cells containing the same, and methods of producing a polypeptide using said host cells is acknowledged. At applicant's request, it is noted that claim 19 is included in invention II, drawn to isolated polypeptides. Claims 19-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No.9. Applicant's traversal of the restriction has been fully considered but have not been found persuasive in overcoming the restriction requirement. Applicant argues that it would not be a serious burden to search both the polynucleotides and the polypeptides of the instant invention. However, as noted in the previous action, polynucleotides and polypeptides are significantly different in terms of structure, chemical, physical, and biological properties and function both *in vitro* and *in vivo* by significantly different mechanisms such that the products can

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the products can be used for significantly different methodologies. As such, the search for isolated polynucleotides and the search for isolated polypeptides is significantly different. Therefore, restriction for examination purposes is proper and the restriction requirement is maintained.

As noted above, claims 1-18, which corresponded to invention I have been canceled. Applicant identifies new claims 24-305 as belonging to invention I. However, the subject matter of claims 24-305 requires further restriction as follows.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I(a). Claims 24-159 and 287-305, drawn to isolated polynucleotides which encode TNFR-6 $\alpha$ , recombinant vectors containing the same, host cells containing the same, and methods of producing a polypeptide using said host cells, classified in classes 536 and 435, subclasses 26.1, and 325 or 320.1.
- I(b). Claims 160-284, drawn to isolated polynucleotides which encode TNFR-6 $\beta$ , recombinant vectors containing the same, host cells containing the same, and methods of producing a polypeptide using said host cells, classified in classes 536 and 435, subclasses 26.1, and 325 or 320.1.

Inventions I (a) and I (b) are patentably distinct in that the isolated polynucleotides of inventions I (a) and I (b) encode different genes identified by the specification as TNFR-6 $\alpha$  and TNFR-6 $\beta$  respectively. While both genes are putative members of the same receptor families, the genes and derived gene products are patentably distinct each from the other in that the

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polynucleotides themselves and the encoded proteins have distinct chemical, physical, and functional properties which require separate search and consideration. Further, the vectors and cells used in the methods to produce a TNFR-6 $\alpha$  polypeptide cannot be used to produce a TNFR-6 $\alpha$  polypeptide and vice versa.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their divergent subject matter and separate search requirements, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication from the examiner should be directed to Anne Marie S. Beckerleg, Ph.D., whose telephone number is (703) 306-9156. The examiner can be reached Mon-Thurs and every other Friday from 9:30-7:00. If the examiner is not available, the examiner's supervisor, Karen Hauda, can be reached at (703) 305-6608. General inquiries should

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be directed to the group receptionist whose phone number is (703) 308-0196. The official fax number is (703) 308-4242.

Dr. A.M.S. Beckerleg

*Karen M. Hauda*  
KAREN M. HAUDA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600